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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

EPSTEIN *et al.*

Appl. No. 09/650,339

Filed: August 28, 2000

For: **Metal Binding Compounds and  
Their Use in Cell Culture Medium  
Compositions**

Art Unit: 1651

Examiner: Guttman, H.

Atty. Docket: 0942.4630001/RWE/BJD



**Reply To Restriction/Election Requirement**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

In reply to the Office Action dated May 10, 2001, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-37, 44-47, 54 and 55. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse. The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803.

Applicants respectfully assert that the claims in Groups I-III are closely related in subject matter. As such, a search of one group of claims is likely to encompass subject matter pertinent to the patentability of all groups. As the Examiner has stated, "[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together. . . ." Office Action at page 2, third paragraph, lines 1-2. In the present case, claim 48 (included in group III) recites a composition comprising the culture medium of claim 1 (included in group I). Hence, groups I

and III are clearly disclosed in the present case as “capable of use together.” In addition, since the methods of group II use a culture medium having the same claimed characteristics as the composition of claim 1, groups I and II are also clearly disclosed in the present case as “capable of use together.” Thus, Applicants respectfully assert that under MPEP §§ 806.04 and 808.01, since the alleged inventions of groups I, II and III have been disclosed as capable of use together, these allegedly distinct inventions are not unrelated and restriction is improper.

Moreover, the second requirement set forth in MPEP § 803 has not been satisfied, *i.e.*, it has not been shown why a serious burden would be imposed on the Examiner if restriction were not required. It should be noted that the two requirements set forth in MPEP § 803 are connected with “and.” Hence, satisfaction of both is required. The Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been established, and “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” MPEP § 803. Hence, reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

In reply to the requirement for an election of species (*see* Office Action at pages 3-4), Applicants hereby provisionally elect iron from claim 2, and a hydroxypyridine derivative from claim 4. This election is made without prejudice to or disclaimer of the remaining allegedly patentably distinct species disclosed and/or claimed, and is made **with** traverse on the same grounds as those provided above for traversal of the restriction requirement. Reconsideration and withdrawal of the election of species requirement is therefore also respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

It is believed that this application is in condition for immediate examination. Early notification to this effect is earnestly solicited.

Respectfully submitted,

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